

Serial No.: 09/976,637
Attorney Docket No.: 10018637-1

REMARKS

The Final Office Action dated May 2, 2007 contained a final rejection of claims 1-11. The Applicants have amended claims 1, 2, 3 and 8. Claims 1-11 are in the case. Please consider the present amendment with the attached Request for Continued Examination (RCE) under 37 C.F.R. § 1.114. This amendment is in accordance with 37 C.F.R. § 1.114. Reexamination and reconsideration of the application, as amended, are requested.

The Office Action rejected claims 1-11 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Krsul et al. (U.S. Patent No. 5,839,119) in view of the Applicants' Background of the Invention.

The Applicants respectfully traverse this rejection in view of the amendments to the claims and the arguments below.

First, record is made of a telephonic conversation with Examiner Ojo Oyeibisi on October 2, 2007 regarding the claims and the cited references. During the telephonic interview, proposed amendments to the claims were discussed in an effort to overcome the outstanding rejections. The above amendments reflect the proposals made by the Applicants' attorney Edmond DeFrank during the conversation.

Specifically, the Applicants' newly amended claims now include that the past activities of an entity are used for at least one recommendation but the specific identity of the entity is kept private so that although specific knowledge of past activities are known by the seller, the past activities are not directly associated with the identity of the entity. In light of these amendments to the claims, the Applicants submit that the combination of Krsul et al. with the Applicants' Background of the Invention does not disclose all of the Applicants' features and Krsul et al. teach away from the claimed invention.

First, Krsul et al. merely disclose a "...method of generating electronic monetary tokens that supports off-line transactions while preventing double-spending." Although "...the provider splits each electronic monetary token into two electronic token halves and associates with each the same serial number..." and the "...electronic token halves when combined recreate the electronic monetary token from which they were generated (see Abstract, FIGS. 4A and 4B and col. 2, lines 19-48 of Krsul et al.), Krsul et al. in combination with the Applicants' background is still missing the Applicants' newly added

feature of having specific knowledge of the past activities, but the past activities are not directly associated with the entity. Instead, when combined with the Applicants' background, the system in Krsul et al. is **explicitly** designed for "**preventing sellers from building a dossier**" by **not** allowing sellers to have activity information [*emphasis added*] (see col. 6, lines 40-48 of Krsul et al.). This is unlike the Applicants' claimed invention which compiles a dossier or past activities for at least one recommendation. However, the specific identity of the entity is kept private so that although specific knowledge of past activities are known, the past activities are not directly associated with the entity.

Next, even though the combined references do not disclose, teach, or suggest the Applicants' claimed invention, the references should **not** be considered together because Krsul et al. teach away from the Applicants' claimed invention. MPEP section 2143.01, part V. clearly states that "[I]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, MPEP section 2143.01, part VI. states that "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Namely, as argued above, the system in Krsul et al. is **explicitly** designed for "**preventing sellers from building a dossier...**" [*emphasis added*] (see col. 6, lines 40-48 of Krsul et al.), unlike the Applicants' claimed invention, which provides past activities for compiling a dossier for the sellers for helping them create recommendations, while the past activities are not directly associated with the entity. Consequently, Krsul et al. teach away because **sellers are prevented** from building a dossier or learning about past activities on any entity, unlike the Applicants' claimed invention. As such, any proposed modifications of allowing sellers to build a dossier would go directly against the **explicit** teachings of Krsul et al. (see col. 6, lines 40-48 of Krsul et al.). This would clearly render Krsul et al. being modified unsatisfactory for its intended purpose and change the principle of operation of the invention in Krsul et al. being modified.

Therefore, this "teaching away" prevents this reference from being used by the

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Examiner. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). Thus, since the Applicants' claimed elements are not disclosed, taught or suggested by the combined references and because Krsul et al. teach away from the Applicant's invention, Krsul et al. cannot be used as a reference alone or in combination with other references, and hence, the Applicant submits that the rejections should be withdrawn. *MPEP 2143*.

With regard to the rejections of the dependent claims, because these rejected claims depend from the above-argued respective independent claims, and they contain additional limitations that are patentably distinguishable over the cited references, these rejected dependent claims are also considered to be patentable (*MPEP* § 2143.03).

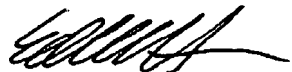
In view of the arguments and amendments set forth above, the Applicants respectfully submit that the rejected claims are in immediate condition for allowance. The Examiner is therefore respectfully requested to withdraw the outstanding claim rejections and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (818) 885-1575.

It is not believed that additional extension of time fees are due at this time; however, if any additional extension of time fees are required in connection with the filing of this Amendment, please charge the extension of time fees to Deposit Account No. 08-2025.

Please note that all correspondence should continue to be directed to:

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Respectfully submitted,
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